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Paper 1
Declared: 21 July 2008

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,650 McK
Technology Center 1600

AMGEN, INC.

(Inventors: Anthony J. Polverino and Roland Luethy),
Patent 7,329,729 B1,
Junior Party,

v.

GENENTECH, INC.

(Inventors: Audrey Goddard, Paul J. Godowski, Austin L. Gurney,
Victoria Smith, Colin K. Watanabe and William I. Wood),
Application 10/143,114,
Senior Party.

Before: Fred E. McKelvey, *Senior Administrative Patent Judge.*

DECLARATION

Part A

Declaration of Interference

An interference is declared pursuant to 35 U.S.C. § 135(a).

Details of the application, patent, count and claims designated as
corresponding or as not corresponding to the count appear in Parts E and F.

1 **Part B**
2 **Designation to manage**
3

4 Senior Administrative Patent Judge Fred E. McKelvey has been
5 designated to manage the interference. 37 CFR § 41.104(a).
6

7 **Part C**
8 **Standing Order**
9

10 A copy of a STANDING ORDER (3 Jan. 2006) (Paper 2)
11 accompanies this DECLARATION.

12 The STANDING ORDER applies to this contested case.

13 **Part D**
14 **Initial Conference Call and Motions Lists**
15

16 Conference Call

17 A conference call to set dates for action in this contested case is
18 scheduled for:

19 **2:00 p.m. (1400 hours Eastern Time) on 03 September 2008.**

20 The Board will initiate the conference call.

21 Motions Lists
22

23 On or before:

24 **Noon (1200 hours Eastern Time) on 28 August 2008,**

25 each party shall file, and on or before:

26 **5:00 p.m. (1700 hours Eastern Time) on 28 August 2008,**

27 each party shall serve a notice stating the relief the party requests, *i.e.*, a
28 motions list including motions the party seeks authorization to file. 37 CFR
29 §§ 41.120(a) & 41.204; STANDING ORDER ¶¶ 104.2.1, 120 & 204.

1 The default procedure for filing and serving motions lists is that
2 motions lists are to be *filed* before being *served*.

3 By filing before service, one party will not have access to an
4 opponent's motions list prior to the filing of the party's motions list.

5 Nevertheless, the parties may mutually agree to discuss and serve
6 motions lists at any time prior to the date and time motions lists are due.

7 The following shall be included in motions lists.

8 (1) Proposed motion for benefit (*i.e.*, to be accorded an
9 earlier constructive reduction to practice) must identify the application(s) for
10 which benefit will be sought.

11 (2) Proposed motion to attack benefit must identify the
12 application(s) to be attacked.

13 (3) Proposed motion seeking judgment against an opponent
14 based on alleged unpatentability must identify the statutory basis for the
15 alleged unpatentability and:

16 (a) if based on prior art, identify the prior art;

17 (b) if based on the first paragraph of 35 U.S.C. § 112,
18 (i) identify whether written description, enablement or best mode will be the
19 basis for the motion, and (ii) briefly identify the basis for any alleged
20 unpatentability;

21 (c) if based on an alleged failure to comply with
22 35 U.S.C. § 135(b), briefly identify the reason;

23 (d) if based on the second paragraph of 35 U.S.C.
24 § 112, identify the limitation which is believed to be indefinite.

25 (4) Proposed motion based on no interference-in-fact shall
26 briefly identify the reason no interference-in-fact is believed to exist.

1 (5) Proposed motion to designate additional claims as
2 corresponding to a count or as not corresponding to a count shall identify the
3 claims involved.

4 (6) Proposed motion to add or substitute a new count shall
5 explain why the added or substitute count is necessary.

6 A motions list shall not contain any "reservation clause" whereby a
7 party purports to reserve a right to file additional motions. Additional
8 motions are those authorized by the Board consistent with the rules.

9 A sample schedule for taking action during the motions phase of the
10 interference appears as Form 2 (page 69) of the STANDING ORDER.

11 Counsel are encouraged to discuss the schedule prior to the
12 conference and agree to on times for taking action generally consistent with
13 the sample schedule.

14 A typical motions phase last about eight (8) months.

15 The parties should be prepared at the conference to justify any request
16 for shorter or longer time periods.

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Part E

**Identification of the Parties
Assignment of Exhibit Numbers
Initiating Settlement Discussions**

Junior Party

Inventors: Anthony J. Polverino, CA
Roland Luethy, CA

Patent: U.S. Patent 7,329,729 B1,
issued 12 Feb. 2008,
based on application 09/724,000,
filed 28 November 2000

Title: Secreted epithelial colon stromal-1
molecules and uses thereof

Real party in interest: Amgen, Inc.

Senior Party

Inventors: Audrey Goddard, CA
Paul J. Godowski, CA
Austin L. Gurney, CA
Victoria Smith, CA
Colin K. Watanabe, CA
William I. Wood, CA

Application: 10/143,114,
filed 09 May 2002

Title: The PRO3446 polypeptides

Real party in interest: Genentech, Inc.

1 Assignment of Exhibit Numbers

2 Senior party: Exhibit Numbers 1001 through 1999.

3 Junior party: Exhibit Numbers 2001-2999.

4 Board: Exhibit Numbers 3001-3999.

5

6 Initiating Settlement Discussions

7 STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)

8

9 The senior party is responsible for initiating settlement discussions
10 required by the STANDING ORDER.

11

Part F

12

Count 1 and Claims of the Parties

13

Count 1

14

15 A composition of matter according to claim 77 of application
16 10/143,114 or a composition of matter according to claims 1, 2, 4, 7
or 10 of patent 7,329,729 B1.

17

The claims of the parties are:

18

Amgen: 1-12

19

Genentech: 77-78 and 82-84

20

The claims that correspond to Count 1 are:

21

Amgen: 1-12

22

Genentech: 77-78 and 82-84

23

The claims that do not correspond to Count 1 are:

24

Amgen: None

25

Genentech: None

1 The parties are accorded an earlier constructive reduction to practice
2 (*i.e.*, benefit for the purpose of priority) of the following applications:

3 Amgen: Application 09/599,087,
4 filed 21 June 2000

5
6 Genentech: application 10/028,072,
7 filed 19 December 2001

8
9 PCT US00/32678,
10 filed 01 December 2000

11
12 provisional application 60/170,262,
13 filed 09 December 1999

Part G
Heading to be Used on Papers

The following heading shall be used on all papers filed in this
interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].

Filed by: [name of party] Paper _____
[Name of attorney] Date filed: [enter date emailed to Board]
[Email address of attorney]
[Telephone number of attorney]

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Title of Paper, *e.g.*, [Name of party] MOTION 1

1 **Part H**
2 **Order Form for Requesting File Copies**

3 When requesting file copies, a party shall use STANDING ORDER
4 Form 4 (page 71).

5 Use of form 4 will expedite processing of any request.

6 A party should attach to any request for file copies a photocopy
7 of Part E (for involved files) and Part F (for benefit files) of this
8 DECLARATION with a hand-drawn circle around the patent and
9 application files for which a copy of a file wrapper is requested.

10 The parties are advised that a single order for file copies may be filled
11 by the Office of Public Records at different times. STANDING ORDER
12 ¶ 109.2 (Paper 2, pages 25-27).

1 **Part I**
2 **Required Paragraph of Affidavits and Declarations**
3

4 The Board has experienced cases in which a witness has belatedly
5 advanced reasons why the witness would be unable to appear for cross
6 examination at a reasonable time and place in the United States.

7 Consequently, to prevent surprise and hardship to the party relying on
8 the testimony of a witness, the following paragraph must be included on the
9 signature page of all affidavits (including declarations) filed in this case.

10 STANDING ORDER ¶ 157.2 (Paper 2, pages 52-53).

11
12 In signing this [affidavit] [declaration], I understand that the
13 [affidavit] [declaration] will be filed as evidence in a contested
14 case before the Board of Patent Appeals and Interferences of
15 the United States Patent and Trademark Office. I acknowledge
16 that I may be subject to cross examination in the case and that
17 cross examination will take place within the United States. If
18 cross examination is required of me, I will appear for cross
19 examination within the United States during the time allotted
20 for cross examination.

1 (via Federal Express and electronic mail):
2
3 Attorney for Amgen:
4
5 McDonnell Boehnen Hulbert & Berghoff LLP
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8 Chicago, IL 60606
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14 Attorney for Genentech:
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